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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,650	12/16/2003	James Wong	SUPERCON 23	5354
7590	10/13/2005		EXAMINER	
Norman P. Soloway HAYES SOLOWAY P.C. 130 W. Cushing Street Tucson, AZ 85701			NGUYEN, DONGHAI D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/736,650	Applicant(s) WONG, JAMES	
	Examiner Donghai D. Nguyen	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/7/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed May 12, 2004 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.
2. The information disclosure statement filed May 12, 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because: the IDS are listed for different application; no column with blank space for Examiner to Initial and considered the document; and no signature line for Examiner to sign and date. They have been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrases “the stack” (claim 1, line 8) and “the elongated billet” (claim 1, line 13) lack antecedent basis.

The scope of claims 8 and 9 are not clear because claims directed to method invention however their preambles direct to product invention (see Claims 8 and 9, line 1). It is suggested that claims 8 and 9 should be canceled.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,869,196 to Wong et al.

Regarding claim 1, Wong et al disclose a process for making superconducting material useful for forming electrolytic devices comprising the steps of: a) establishing multiple niobium or tantalum components (2) in a primary billet of a ductile material (3); b) working the primary

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billet to a series of reduction steps to form said niobium or tantalum components into elongated elements (Col. 5, lines 35-50); c) cutting and restacking the elongated elements from step d) around a metal core (5) and surrounding the stack with a porous confining layer (6/7) to form a secondary billet (Figs. 3a-c); d) working the secondary billet from step c) through a series of reduction steps (Col. 6, lines 1-6); including twisting and rolling into thin ribbon with an Aspect Ratio of greater than 5:1 (inherently teach the twisting and rolling since Col. 15, lines 23-36 disclose the billet are shaped into flatten ribbons 17 see Figs. 6-7 by jelly-roll method which including twisting and rolling. see Fig. 11 of US Patent 5,554,448 reference for more details about jelly-roll method); e) cutting the elongated billet from step d) into sections (Col. 6, lines 11-19); and f) leaching the core and sheath at least in part (Col. 6, lines 36-38).

Regarding claims 2-4, Wong et al disclose the leaching is in an acid leach (Col. 6, line 20); in a liquid metal bath comprises molten magnesium (Col. 9, line 48).

Regarding claims 5, see Fig. 3b.

Regarding claim 6, see Fig. 3c.

Regarding claim 7, Wong et al disclose several separate segments are used to construct a multi anode capacitor assembly (See Col. 6, lines 48-49).

7. Claims 8 and 9 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Wong et al.

Regarding product by process claims 8 and 9 of the present invention, Wong disclose an electronic device/electrolytic capacitor (Fig. 4b) is made from the superconductor material (see Col. 4, line 1). Further, Applicant is referred to MPEP section 2113.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references cited for their teaching of manufacturing superconductor devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (571)-272-4566. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571)-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN
October 3, 2005


MINH TRINH
PRIMARY EXAMINER